

Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

Repeated Request for telephone interview

With the amendment filed after the Decision of the Board of Patent Appeals and Interferences dated February 12, 2007, I requested a telephone interview. I did not hear from the Examiner and I now repeat that request.

Claim Rejections - 35 USC § 102

Claims 1 and 3-5 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,468,556 to Fuss. The following arguments apply to these unamended claims.

The Examiner has taken the position that the Board of Patent Appeals and Interferences rejected these claims as being anticipated by Fuss. In view of the amendments to these claims after issuance of the Board's opinion, the Board has not actually considered these claims. Because the Board did not consider the present claims, which include limitations not present in the claims on appeal, it is respectfully submitted that the Examiner cannot rely solely on the decision of the Board in rejecting the present claims.

Although the Board determined that Fuss punches holes in its starting sheet stock material to produce dunnage strips that are relatively less dense than the starting material (see the Board's opinion, page 7), Fuss's punched strips do not have at least two layers fixed in an overlapping relationship, which is the case in the current (unamended) claim 1.

Nevertheless, the Examiner has taken the position that since Fuss discloses chipboard as a stock material, Fuss discloses a dunnage product with multiple layers. We respectfully submit that the ordinary skilled person of Fuss would not normal consider chipboard to have multiple layers of sheet stock material for converting into a dunnage product. The Examiner is asked to provide evidence in support of his position to the contrary.

The Examiner also relies on the Board's position that Fuss subsequently uses a positioning device to position portions of the punched strips in juxtaposition and then connects the juxtaposed portions to hold them together. The figures cited by the Examiner in support of a multi-layer strip of dunnage represent Fuss's completed dunnage product. Admittedly, those dunnage products have multiple layers. But then Fuss does not disclose a positioning device that acts on the completed dunnage product. Consequently, the Examiner's position that Fuss anticipates the claimed system appears to be incorrect for lack of such a positioning device. Withdrawal of the rejection is requested.

Claim Rejections - 35 USC § 103

Claims 4-9 and 23 stand rejected under 35 USC § 103(a) over Fuss in view of U.S. Patent No. 6,251,054 to Cruz et al. or U.S. Patent No. 5,643,647 to Wischusen, III.

The Examiner maintained this rejection based solely on the Board's Decision. As noted above, the claims have been amended since the Board's Decision and the Board did not consider the pending claims. The Examiner's rejection is therefore improper for failing to particularly point out the basis for this rejection. The Examiner must explain why and how the person of ordinary skill in the art would combine the teachings of the references to derive the claimed system. Since the Board did not address all of the limitations of the pending claims, the current rejection is improper and should be withdrawn.

Amendments

To further clarify the distinctions between Fuss and the claimed system, we proposed amending the claims in the manner shown.

Entry of the above amendments to the claims is respectfully requested.

Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Application No.: 10/702,225
Atty. Docket No.: RANPP0348USA

Respectfully submitted,

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Date: June 21, 2007

/Christopher B. Jacobs 37,853/

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